

### Remarks

Claims 1-5 and 7-19 are pending and stand rejected. Applicants assert that the claims are in condition for allowance after final as set forth more fully below.

### Interview Summary

The undersigned participated in a telephone interview with the Examiner in December of 2005. During the interview, it was discussed that a PC card device as in Madsen that includes an RJ-45 jack to connect to a POTS circuit must convert the POTS signal into a PCMCIA bus signal, which is a digital signal at a much lower voltage and that utilizes an entirely different bus signaling protocol than POTS, such that the PCMCIA card cannot receive POTS at the external side via the RJ-45 while also outputting POTS signals via a connector on the opposite side since the connector on the opposite side may only output PCMCIA bus signals to the computer to be operative.

### 103 Rejections

Claims 1-5 and 7-19 stand rejected under 35 USC 103(a) as being unpatentable over Madsen (US Pat. 6,174,205) in view of "Corning, Toolless Wall-mount Distributed Microfilter, July 2001" ("Corning"). Applicants respectfully traverse these rejections.

The Office Action has rejected base claims 1, 7 and 11 by stating that Madsen teaches all of the elements except the steps of receiving a combined POTS/DSL signal and then separating these signals by filtering. However, the Office Action states Corning teaches the filtering of a combined POTS/DSL signal such that it would have been obvious to combine Corning (wherein the filter is most likely inside the [PCMCIA] cartridge 52 (See, Office Action Page 5)), with the disclosure of Madsen to render claims 1, 7 and 11 obvious.

However, claims 1, 7 and 11 each recite similar subject matter that is either not disclosed by the purported combination, or in the alternative, would render the Office Action's asserted combination to be non-functional. Regarding the purported combination being inoperative, the asserted combination cannot be unsatisfactory for its intended purpose and, as such, there is no suggestion or motivation to make the asserted combination. In re Gordon, 733 F.2d 900 (Fed. Cir. 1984); MPEP 2143.01.

Furthermore, the prior art can be modified or combined to reject claims as obvious only as long as there is a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091 (Fed. Cir. 1986); MPEP 2143.02. As noted above, the purported combination providing a POTS output from the PCMCIA card is inoperative such that the PCMCIA card is rendered unsatisfactory for its intended purposes and because it would be inoperative, there is no expectation of success. The purported combination fails to render the claims unpatentable for at least these reasons.

#### Claim 1

As a representative example, claim 1 recites among other things:

“a telephone ... the first end including at least one electrical connector for engaging the corresponding electrical connector for the POTS circuitry... the filter cartridge comprises circuitry to receive a signal through the at least one second connector of the second end that contains both DSL and POTS signals, to filter the DSL signal out so as to pass substantially only the POTS signal to the at least one electrical connector of the first end, and to simultaneously pass the DSL signal to the at least one first connector of the second end for receiving the DSL line.”

In short, claim 1 requires that the POTS signal be outputted from the first end to the at least one electrical connector connected to the POTS circuitry, all of which occurs inside the housing. Furthermore, it is commonly known in the art that POTS signal operates at approximately -48 volts DC.

The Office Action asserts that the Madsen device is directly connected to a phone line **114/116** and a PCMCIA card **52**, that the Corning POTS/DSL filter would be inside the PCMCIA card **52** and that the PCMCIA card would terminate inside the telephone housing **14**. As commonly known in the art, a PCMCIA card terminates into a PCMCIA bus that operates at approximately 3V and utilizes a particular signaling protocol specific to PCMCIA buses. In order for the purported combination to disclose the language of the present claims, the PCMCIA card would necessarily be required to receive POTS signals, and rather than converting them to PCMCIA bus signals, outputting POTS signals at the opposite side. Thus, the purported combination would therefore require the -48V POTS signal to connect to a PCMCIA bus (an electrical connector connected to a POTS circuit) in order for the PCMCIA card to seat and function. However, connecting a -48v POTS output signal into a 3V PCMCIA bus would be nonfunctional as the PCMCIA bus is for

receiving PCMCIA signals, such as those converted from a POTS signal received on the opposite side. However, the language of the claims recites that the POTS signal is output. If the PCMCIA card is modified to NOT provide conversion from POTS to PCMCIA in order to be applicable to the claim recitations, then the POTS signal being output via the PCMCIA connector would likely overload the PCMCIA bus and render it inoperative. In addition, it is well known in the art that in addition to the voltages being different, the signaling methodology of POTS is also different and incompatible with the signaling methodology of a PCMCIA bus. Thus, the purported combination that would require the PCMCIA card to output the POTS signal to the computer in order to meet the claim recitations would also be nonfunctional for this additional reason.

In the final rejection, the Office Action appears to assert that simply because the PCMCIA card may receive a POTS signal via an RJ-45 jack, that it is within the ability and purpose of the PCMCIA card to also output the received POTS signal to the PCMCIA bus of the computer. Specifically, the Office Action states “ It is not seen that connecting a -48V POTS output signal into a 3V PCMCIA bus would overload the PCMCIA bus.” This statement is offered without any explanation of how a 3V bus can work with a -48 Volt signal, nor how a bus that carries digital data according to a bus signaling protocol can operate with an entirely different analog signal. Furthermore, this line of reasoning appears to ignore that the PCMCIA card does a conversion of the POTS signal to the PCMCIA bus signal, in terms of protocol and voltage. An example would be a PCMCIA modem where a POTS signal is converted to a PCMCIA signal suitable for the PCMCIA bus. Applicants contend that it is entirely contrary to the ability and purpose of the PCMCIA card to receive POTS signals at the external connector and then output the POTS signals through the internal connector to the computer’s PCMCIA bus.

Thus, to prevent an inoperable condition in the PCMCIA bus as discussed above, the POTS/DSL filter would have to be outputted to intervening circuitry also inside the PCMCIA card such that the POTS signal would no longer be outputted the first end opposite the external side of the PCMCIA card since PCMCIA signals would be output instead. By outputting the PCMCIA signals, the operable combination would then fail to disclose all of the claim recitations of claim 1. Because the combination of Madsen and

Corning would either be non-functional or would otherwise fail to disclose all of the elements of claim 1, claim 1 is allowable over this purported combination.

#### Claims 7 and 11

Claims 7 and 11 recite subject matter similar to that in claim 1. Claim 7 recites:

“A filter cartridge adapted for use with a telephone comprising a first end and second end, the first end being adapted to be inserted into a location within a housing of the telephone; the first end including at least one electrical connector for engaging a corresponding electrical connector within the telephone that is for carrying POTS signals to POTS circuitry of the telephone and... wherein the cartridge includes circuitry to filter the DSL signal out of the signal received...so as to output substantially only the POTS signal through the at least one electrical connector of the first end and output the DSL signal through the at least one DSL connector of the second end.”

Claim 11 recites:

“A filter cartridge adapted for use with a telephone comprising a first end and second end, the first end being adapted to be inserted into a location within a housing of the telephone, the first end including at least one electrical connector for engaging a corresponding electrical connector within the telephone that is for carrying POTS signals to POTS circuitry of the telephone... a filter that removes the DSL signal so as to output substantially only a POTS signal through the at least one electrical connector of the first end...”.

As discussed in relation to claim 1, the combination of Madsen and Corning as asserted by the Office Action regarding claims 7 and 11 again necessarily requires that a POTS signal be transferred from the PCMCIA card to a connector within the housing (a PCMCIA bus) in order for the PCMCIA card to seat and function. In that case the -48V POTS signal would again be incompatible with the 3V PCMCIA bus and malfunction. As such, the combination of Madsen and Corning would again be non-functional or would require a conversion from a POTS signal to a PCMCIA signal which is contrary to the recitations of these claims.

Accordingly for at least the reasons given above, claims 1, 7 and 11 are allowable over the cited combination of Madsen and Corning for at least these reasons. Dependent claims 2-5, 8-10 and 12-19 depend from allowable claims 1, 7 and 11 and are also allowable for at least the same reasons.


Conclusion

Applicants assert that the application including claims 1-5 and 7-19 is in condition for allowance after final. Applicants request reconsideration after final in view of the remarks above and further request that a Notice of Allowability be provided. Should the Examiner have any questions, please contact the undersigned.

No fees are believed due. However, please charge any additional fees or credit any overpayment to Deposit Account No. 50-3025.

Respectfully submitted,

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